

#### **IV. Remarks/Arguments**

Applicant appreciated Examiner's willingness to tentatively set up, in response to Applicant's earlier request, a possible Examiner's Interview at the U.S. Patent Trademark Office. However, an Interview was not possible for Applicant and Attorney for  
5 Applicant prior to the due date for responding to the Office Action. Accordingly, Applicant provides a response herein to the Office Action but would look forward to the opportunity to go over the Office Action if deemed helpful to advance prosecution of this application.

##### **10 A. Regarding the Specification**

The abstract and disclosure have been amended as noted in the Amendments to the Specification above, as Examiner requested in view of several informalities. These amendments have been made for clarification and not for purposes of patentability, as presented in this document.

15 In view of the foregoing, and the present amendments, applicant respectfully requests withdrawal of the objections.

##### **B. Regarding the Claims**

Certain amendments have been made to various claims and other various  
20 amendments have also been made as noted in herein. Various amendments have been made to clarify the claims and not for purposes of patentability, as presented in this document.

##### **1. Examiner's request regarding claims 83 and 85-89**

25 Examiner has asked Applicant to change claims 83 and 85-89. Applicant acknowledges Examiner's request. Please note that Applicant has made the foregoing amendments to the claims for clarification and not for reasons of patentability. In view of the present amendments, Applicant respectfully submits that the claims are now in accord with the Examiner's request.

## 2. Section 102

The Examiner has cited various references with respect to Applicant's independent claim 1 and Applicant herein has provided remarks to show that claim 1 is patentable in view the cited references. Applicant respectfully points out that the pending claim 1 herein states "for separating at least some nucleic acid" which the cited references do not disclose. The Shapiro patent, which issued much earlier, on May 19, 1970, does not disclose or appear to contemplate anything about separating at least some nucleic acid. In addition, the Card reference also does not disclose separating at least some nucleic acid. The Office Action also cites the Forsythe reference which discusses to a certain extent separating fluids; Applicant notes that Forsythe does not disclose at least some nucleic acid.

In view of the embodiment as recited in the pending claim 1, Applicant respectfully traverses the Office Action regarding the foregoing. The Shapiro, Card and Forsythe references, fail to show each and every feature as noted in combination with the other elements in the embodiment as recited in the pending claim 1. In this way, claim 1 is patentable over the cited references. (It should be noted, that in embodiments other than those of claim 1, the other types of separation other than as noted above may be accomplished in other embodiments. Please note that with regard to the remarks herein, Applicant does not intend for these remarks to apply to other claims which may be filed directed to embodiments other than claim 1.)

In addition, the Examiner has cited certain references with respect to independent claim 72. Applicant provides remarks herein to show that the embodiment of claim 72 as well is patentable in view the cited references. Applicant notes that the pending claim 72 also states "for separating at least some nucleic acid" which the cited references do not disclose.

The Dorn patent does not have any disclosure regarding separating at least some nucleic acid and does not appear to contemplate same. That is, claim 72, as pending, includes features not anticipated by Dorn. The Ayres patent also lacks the features of

claim 72. The Office Action asserts Ayres discloses filtering; Applicant notes that Ayres does not disclose separating at least some nucleic acid.

Regarding the embodiment of claim 72, Applicant respectfully traverses the Office Action concerning the foregoing and the dependent claims of claim 72 as noted.

5 Both of the Dorn and Ayres patents, lack each and every feature as noted in combination with the other elements in the embodiment as recited in the pending claim 72. Accordingly, claim 72 is patentable over the references cited in the Office Action. (Applicant notes that the remarks herein do not apply to other claims which may be filed directed to embodiments other than in claim 72.)

10 Applicant also notes that the remarks with regard to the embodiment of independent claim 72 distinguishing over the cited references also apply to the dependent claims indicated in the Office Action (e.g., 73-76, 81, 83-84, and 87-89) and traverses the Office Action regarding same. In view of the pending embodiment of the base independent claim 72, the respective dependent claims are now distinguishable over the  
15 cited references.

### **3. Section 103**

The Examiner has indicated certain references under Section 103 as regards Applicant's independent claim 72. Applicant provides the following remarks to show  
20 that there is no suggestion to modify or combine the references, no reasonable expectation of success regarding the modification or combination, or no teaching or suggestion of Applicant's claims now pending. As noted above, Applicant has amended the base independent claim 72 to include "for separating at least some nucleic acid."

The embodiments of claims 77 and 79-82 are dependent on the embodiment of  
25 claim 72. (Applicant also requests further clarification regarding the Office Action as it pertains claims 77 and 79-82 and if claim 72 was to be included). In view of claim 72 as now amended, neither the Ayres reference nor Kozak reference, individually or in combination, teach or suggest the features of claim 72. Moreover, there is no indication

of any reasonable expectation of success regarding such a combination. Both the Ayres and Kozak references lack teaching regarding nucleic acid.

Regarding claims 72-73, 75-77, 79, 81, 83-85, as noted above, the base independent claim 72 includes nucleic acid. The Forsythe and Finney references do not  
5 teach or contemplate such a feature and there is no motivation to combine the references “for separating at least some nucleic acid.”

With regard to claims 72-74, 76, 78 and 83-84, Shapiro is directed to a test tube filter device. However, any combination of the Shapiro and Finney references as asserted in the Office Action, do not contemplate, teach or provide any motivation, together or  
10 individually, suggesting a vessel for processing substances and separating at least some nucleic acid.

Regarding claims 72-73, 83-84 and 86, there is no suggestion in Savas or in Finney (as discussed above) and which issued earlier on November 9, 1982, to combine the references to arrive at the embodiment in claim 72 as now amended. Savas sets forth  
15 a filtering device. Savas does not teach anything regarding nucleic acid and there is no suggestion to modify or combine the teaching of the Savas and Finney references to provide a vessel for processing substances and separating at least some nucleic acid. Even if Savas and Finney could be combined, there is nothing to indicate any reasonable expectation of success regarding the modification or combination, and no teaching or  
20 suggestion to arrive at Applicant’s claims now pending.

With respect to the embodiment of claim 72 including the dependent claims of claim 72 as noted, Applicant respectfully traverses the Office Action concerning the foregoing. In addition, Applicant notes that the remarks with regard to the embodiment of independent claim 72 distinguishing over the cited patents also apply to the dependent  
25 claims indicated in the Office Action (e.g., 73-88) and traverses the Office Action regarding same. In view of the pending embodiment of the base independent claim 72 and the respective dependent claims, none of the references, alone or in any appropriate combination that would avoid hindsight, suggest all of the features of the claims as amended. (Applicant notes that the remarks herein do not apply to other claims which

may be filed directed to embodiments other than in claims 72 or its respective dependent claims.)

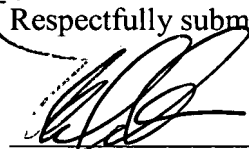
Applicant also notes that the remarks herein are made only with respect to the embodiment recited in claims 1 and/or 72 and the indicated dependent claims, as noted above, and reserves the right to provide any further clarification or correction regarding the remarks or other claims. The remarks herein are not made--and are not an admission that they apply or are otherwise related--with regard to any other embodiment of the above-referenced application, any other embodiment of a claim or those presented hereinafter.

For all of the above reasons, applicant respectfully submits that claims 1, 72 and the respective dependent claims are patentable over the cited art and are allowable.

Please note that Applicant would welcome any further communications regarding Examiner's Office Action or Applicant's Remarks or response if it would be helpful to expedite prosecution of the application.

Respectfully submitted,

Date: May 14, 2007

  
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Michael A. Evans  
Reg. No. 57,028  
DeWalch Technologies, Inc.  
6850 Wynnwood Lane  
Houston, Texas 77008  
Tel.: 713-861-8993  
Fax: 713-861-8997  
ATTORNEY FOR APPLICANT